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JAN 24 2005
PAT & TRADEMARK OFFICE

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
127/02185

In Re Application Of: **Zion AZAR**

Application No. 09/828,997	Filing Date April 9, 2001	Examiner ROLLINS, Rosiland S.	Customer No. 44909	Group Art Unit 3739	Confirmation No. 1331
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Title: **METHOD OF SELECTIVE PHOTOTHERMOLYSIS OR HAIR REMOVAL**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Petition with Respect to Finality of a Rejection Under 37 CFR 1.181 and with Respect to an Objection Under 37 CFR 1.75(c), including petition fee (see below)

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **03-3419** as described below.
- ☐ Charge the amount of _____
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WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Paul Fenster

Signature

Dated: **January 24, 2005**

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CC:

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Zion AZAR
Serial Number: 09/828,997
Filed: April 9, 2001
For: METHOD OF SELECTIVE PHOTOTHERMOLYSIS OR HAIR
REMOVAL
Art Unit: 3739
Examiner: ROLLINS, Rosiland S.

Mail Stop Patition
Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria VA 22313-1450

**PETITION WITH RESPECT TO FINALITY OF A REJECTION UNDER 37 CFR 1.181
AND WITH RESPECT TO AN OBJECTION UNDER 37 CFR 1.75(c)**

Sir:

Further to an Office Action dated December 10, 2004, applicant hereby petitions the commissioner to withdraw the objection to claims 29-40 and/or to withdraw the finality of the rejection of claims 5, 6, 42/5, 42/6, 7 and 42/7.

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REMARKS

In an office action dated June 7, 2004 claims 3-40 were rejected under 35 U.S.C. §102(b) as being anticipated by Chen et al.

In response, in a response dated September 7, 2004, claims 5, 7, 10, 14 and 24 were placed into independent form, claim 23 was placed into independent form and amended. Claims 8, 9, 11-13, 16-22, 25-28 were cancelled and claims 29-40 were put into multiply dependent form, being dependent, in the alternative, on claims previous to these claims and also on new claim 41. Claims 41 and 42 were added.

This resulted in the application containing claims 3-7, 10, 14, 15, 23, 24 and 29-42.

In the present final rejection dated December 10, 2004 claims 29-40 were objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer back to a preceding claim. These claims were not treated on the merits.

In addition, claims 3, 4, 10, 14, 15, 41, 42/2, 24, 42/10, 42/14 and 42/24 were rejected under 35 U.S.C. §102(b) as being anticipated by Chen, et al. This is the same rejection as in the previous action.

In addition, claims 5, 6, 42/5, 42/6, 7 and 42/7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chen et al. It is noted that while this is the same reference as cited against unamended claims 5, 6, and 7 in the previous rejection, the grounds of rejection was changed from anticipation to obviousness.

Claims 23 and 42/23 were rejected under 35 U.S.C. §103(a). Since claim 23 was amended, this rejection is not the subject of this petition.

DISCUSSION**I: Objection to claims 29-40**

Applicants petition the Commissioner to set aside the finding that claims 29-40 are in improper form. In a conversation with the Examiner, the Examiner presented the position that while a singly dependent claim could, after amendment, refer to a later claim this was not the case with a multiply dependent claim.

Applicants can find no basis in 35 CFR §1.75(c) or in MPEP §608.01(n) for the Examiner's position.

35 CFR §1.75(c) reads, in part:

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"One or more claims may be presented in dependent form referring back to and further limiting another claim or claims in the same application."

This section clearly refers to both singly and multiply dependent claims. This is recognized by the parallel wording in MPEP §608.01(n) I: MULTIPLY DEPENDENT CLAIMS and MPEP §608.01(n) IV: CLAIM FORM & ARRANGEMENT. In I, the MPEP states:

"Generally, a multiply dependent claim is a dependent claim which refers back to more than one dependent or independent claim."

In IV, the MPEP states:

"A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim, which, in turn refers to another preceding claim."

The MPEP recognizes that during prosecution there is the real possibility that an old claim would be made to refer to a later claim, which is introduced later, for example. While it would be possible to require that the present claims be cancelled and a new set of reorganized claims be presented, this would make it difficult to follow the changes made during prosecution. Thus, in a later paragraph in IV, the MPEP states, without referring specifically to singly or multiply dependent claims:

"During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim."

The Examiner in the above referenced conversation, indicated her belief that this paragraph referred only to singly dependent claims. However, this is not what the MPEP says, since this statement is made without reference to the type of claims. Furthermore, the situation described occurs equally with multiply dependent as with singly dependent claims.

In addition, in MPEP §608.01(n) (I) F: Handling of Multiple Dependent Claims by the Examiner, the MPEP states:

"If any series of dependent claims contains a claim with an improper reference to a numerically following claim *which can not be understood*, the claim referring to a following claim should normally be objected to and not treated on the merits.

However, in situations where a claim refers to a numerically following claim and *the dependency is clear, both as presented and as will be renumbered at issue*, all claims should be examined and no objection as to form need be made."

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Applicants submit that the Examiner has misconstrued the second quoted statement from section IV as applying only to singly dependent claims. Furthermore, even if the Examiner is correct that this is the proper construction, the second paragraph of the last quoted section should certainly apply to the present situation. In each of the objected to claims, the objection is based on the dependency on claim 41. Claim 41 is dependent on claim 3, an independent claim. Thus, the dependency is quite clear as is. Furthermore, on renumbering claim 41 would appear soon after claim 3 and there would be no lack of clarity in the dependency. Thus, whether the Examiner is correct or not as to whether, in principle, multiply dependent claims can depend on subsequent claims after amendment, the Examiner should have examined the claims and not object to them.

II: Finality of the Rejection.

Applicants petition the Commissioner to set aside the finality of the rejection.

As indicated above, the unamended claims remain rejected in view of the same art as in the prior office action. However, applicants submit that changing the rejection from one of anticipation to one of obviousness constitutes a "new ground of rejection." The Examiner in the above referenced discussion indicated that so long as the same art was used, the finality of the rejection was proper. Applicant submits that the Examiner's premature rejection of the unamended claims is improper according to the literal reading of the MPEP.

MPEP §706.07(a) states, in part:

"Under present practice, second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement."

As previously stated, claims 5, 6, 42/5, 42/6, 7 and 42/7 stand rejected under §103 for obviousness over Chen et al. in view of common knowledge in the art. However, these claims were previously rejected under §102 over just Chen et al. This new basis for rejection would normally require the applicants to submit a new response based on different legal grounds than the §102 rejection, therefore this is a new ground of rejection. Applicant notes that these claims were not amended in the last Office Action response. Furthermore, rejection of the claims is not based on any information submitted in an information disclosure statement. According to the MPEP, a new ground of rejection which is not based on a claim amendment and not based on information submitted in an information disclosure statement should not be made final.

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Therefore, the Examiner's position goes against the standards of examination as set forth in the MPEP.

Not only does the Examiner's premature rejection of the application contravene the literal provisions of MPEP, the Examiner goes against its intent. The purpose and intent of this section of the MPEP is to provide the patent application process with a fair and reasonable means of bringing prosecution to a close. However, it specifically states that if a new ground of rejection is introduced then the subsequent office action should not be final. The MPEP has this provision because to reject the application on new grounds, without affording the applicant an opportunity to respond, is unfair and unreasonable. In other words, it deprives the applicant of due process. To prematurely bring patent prosecution to a close defeats the purpose of having patent applications and prosecution in the first place. The fundamental concept behind the patenting process is to examine applications and grant those that are eligible for protection and deny those that aren't. If an application's prosecution is brought to a premature close, then the determination of worthiness has not been concluded. If this premature final rejection is allowed to remain, then this application will not have been properly evaluated on its merits.

In conclusion, the Examiner's premature rejection of the unamended claims 5, 6, 42/5, 42/6, 7 and 42/7 is improper for at least two reasons. First, MPEP §706.07(a) indicates that a new grounds for rejection, in this case switching from §102 to §103, without the claims first having been amended and without using information from a new information disclosure statement shall not be couched as a final office action. Second, a premature final rejection deprives the applicant of due process and contravenes the intent of the MPEP, which is to allow applicants to respond to new grounds of rejection so that applications are properly judged on their merits.

It should be understood that if this final rejection is not overturned, the Applicant will not have been given any opportunity to amend the claims or even to properly argue them. It flies in the face of reason to expect that every applicant has to try to figure out what rejections the Examiner might make, and counter those hypothetical, potential arguments before they are made. Therefore, the applicant respectfully requests that the finality of the office action dated December 10, 2004 be overturned.

Applicant further points out that a 2-page 1449 form, filed in a First Supplementary Information Disclosure Statement on March 22, 2002, and later resubmitted with the response dated September 7, 2004, was not received initialed by the Examiner. Applicant is again

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resubmitting the form herewith and respectfully request that the items listed thereon be initialed by the Examiner to ensure that they appear on the face of the patent issuing on the present application. Applicant assumes that the art has already been considered by the Examiner in accordance with MPEP §1893.03.

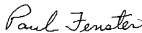
III: Relief Requested

If the petition regarding the objection is granted then applicant respectfully requests that the present action be withdrawn and that a new action, including patentability of claims 29-40 be issued.

If the petition regarding finality is granted then the present office action should be made non-final.

If both issues are decided in applicant's favor then a new non-final office action would appear to be warranted.

Respectfully submitted,
Zion AZAR



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January 24, 2004
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INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

ATTY DOCKET NO.

127/02185

SERIAL NO.

09/828,997

Zhen AZAR

PLING

April 9, 2001

GROUP

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U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILED DATE IF APPROPRIATE
	4,819,669	11 Apr '89	POLITZER, E. J.			
	5,659,192	22 Oct '91	ZALAS, N.			
	5,226,907	13 Jul '93	TANKOVICH, N. I.			
	5,405,368	11 Apr '95	ECKHOUSE, S.			
	5,522,814	04 Jan '96	BERNAZ, G.			
	5,606,798	04 Mar '97	KELMAN, E.			
	5,720,772	24 Feb '98	ECKHOUSE, S.			
	5,814,040	29 Sep '98	NELSON, J. S. et al.			
	5,846,252	08 Dec '98	MIKEL, T. L. Sr.			
	5,871,480	16 Feb '99	TANKOVICH, N. I.			
	5,885,273	23 Mar '99	ECKHOUSE, S. et al.			

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FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
						YES NO
12	EP 0 788 814	13 Aug '97	Europe			
13	WO 99/07438	18 Feb '99	PCT			
14	WO 93/21842	11 Nov '93	PCT			
15	GB 2 124 901	04 Apr '84	England			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

16	DIERICKX, C. C. et al.; "Effective, Permanent Hair Reduction Using a Pulsed, High-Power Diode Laser"; pp. 1-9; retrieved from the Internet at < http://www.coherentmedical.com/ROX_pcrn_final.html > on 19 June 1999
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EXAMINER

DATE CONSIDERED

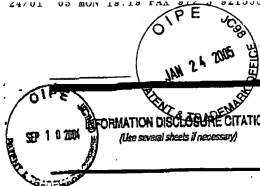
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also form PTO-1440)

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April 9, 2001	3739

U.S. PATENT DOCUMENTS

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